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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,377	06/26/2001	Munetoshi Ono	Q64738	9515

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EXAMINER

HECK, MICHAEL C

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,377

Applicant(s)

ONO, MUNETOSHI

Examiner

Michael C. Heck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a First Office Action in response to the application filed 26 June 2001. Claims 1-20 are pending in this application and have been examined on the merits as discussed below.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: A, B and C on Figure 3 and Figure 4.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: A, E and 2 on Figure 5.

4. The Examiner notes that Figure 5 was specifically identified as the summary drawing of the example with no reference made to any of Figures 1-4. The specification, when specifically referencing Figures 3 and 4 only referred to reference characters 1, 2 and 3 and did not make reference to reference characters A, B and C nor were reference characters A and C identified or associated with a particular entity.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being

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amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 1-17** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For the process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, **claims 1-17** only recite an abstract idea. As to **claim 1**, the recited steps of gathering

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business methods conceived by consumers that coincide with a basic business method concept of a company; and discussing via a communication network at least one of the gathered business methods, between a conceiver of the business method and the company, in order to implement the business method as an executable method does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The method only constitutes an idea for implementing a business method, therefore, deemed to be directed to non-statutory subject matter.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implications of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above. Looking at the claim as a whole, nothing in the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention gathers descriptive material that is used for discussion purposes. The descriptive material does not impart functionality either to the data as so structured, or to the computer since the descriptive material is merely a compilation of facts or data

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that is stored to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer. Therefore the nonfunctional descriptive material does not constitute a statutory process, machine, manufacture or composition of matter. Therefore, the claims as written do not produce a useful, concrete, and tangible result.

Looking at the claims as a whole, nothing in the body of the claims recite any structure or functionality to suggest that a computer performs a task. While claim 2-17 recite a communications network and claim 17 specifically recites the Internet, this amounts to only a means for participants to communicate with each other where nothing is done (i.e., computing) to breathe life into the invention.

Since the claimed invention, as a whole, is not within the technological arts and does not produce a useful, concrete and tangible result as explained above, the same rejection as stated above for claim 1 applies to **claims 2-17**.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. **Claims 1, 4, 18 and 19** are rejected under 35 U.S.C. 102(e) as being anticipated by Abelow (U.S. Patent 5,999,908). Abelow discloses a method and system for implementing a business method conceived by a consumer by participations of consumers comprising:

- **[Claim 1]** gathering business methods conceived by consumers that coincide with a basic business method concept of a company (col. 13, lines 36-58 and col. 20, lines 28-31, Abelow teaches customers assist developing services offered with the product, such as training, documentation, customer support, financing, volume buy discounts, etc. Customers turn into partners for improving products and services by many means such as improvements in product design, product development, major product upgrades and revisions, improving other product uses, and a variety of business activities; etc.); and
- discussing via a communication network at least one of the gathered business methods, between a conceiver of the business method and the company, in order to implement the business method as an executable method (col. 9, lines 47-59 and 13, lines 36-58, Abelow teaches the defined customers desires may be made available on-line. Sellers and customers engage in an evolving dialog during product use. Customers assist defining product features, interfaces, functionalities, etc.);
- **[Claim 4]** selecting one of the business methods implemented as the executable methods by discussing via the communication network, as a core method to be executed (col. 12, lines 43-54, Abelow teaches once a product is on the market the CB-PD Module can be used to accelerate future improvements in the product by means of customer generated suggestions and insights. Specific Customer Design Instruments (CDI) may be used to elicit different information from specific groups of customers (such as by dividing customers functionally by their product uses, or vertically by their market segments).);
- opening to the public via a communication network the core method together with an announcement of gathering proposed business methods conceived by consumers that increase the added value of the core method (col. 12, lines 43-54, Abelow teaches once a product is on the market the CB-PD Module can be used to accelerate future improvements in the product by means of customer generated suggestions and insights. Specific Customer Design Instruments (CDI) may be used to elicit different information from specific groups of customers (such as by dividing customers functionally by their product uses, or vertically by their market segments).); and

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- gathering business methods conceived by consumers via a communication network that relate to the core method (col. 12, lines 43-54, Abelow teaches the speed of this system also plays a role in that it communicates back to the product developers, instantaneously in some cases or at least quickly in many cases, the desires of numerous customers that would otherwise not be known or applied.).

Claims 18 and 19 substantially recites the same limitations as that of claim 1 with the distinction of the recited method being a system. Hence the same rejection for claims 1 as applied above applies to claims 18 and 19.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 2, 3, 10 and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Abelow (U.S. Patent 5,999,908) in view of Kozinets (Kozinets, How Online Communities are Growing in Power, Financial Times, London (UK), 9 November 1998, p.6 [PROQUEST]). Abelow discloses a method and system for implementing a business method conceived by a consumer by participations of consumers but fails to teach at least one additional consumer other than the conceiver, participates in the discussion via the communications network. Kozinets teaches online, loyal consumers evaluate quality together and negotiate standards (para 16). It would have been

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obvious to one of ordinary skill in the art at the time of the applicant's invention to include the online features of Kozinets with the teachings of Abelow since Abelow teaches customers desires may be made available on-line (col. 9, lines 47-59). Time to market is critical for companies in today high technology environment. Abelow teach a customer-based product design module that permits vendors to discover and respond instantly to market shifts and opportunities (Abstract). Kozinets teaches marketers must adapt to and facilitate new "cyborg-friendly" forms of marketing to keep pace with the monumental changes in consumer's everyday information and communications needs (para 38). Being able to electronically communicate with a group of people reduces the time it takes to reach a consensus on market needs, therefore reducing the time it takes to develop the product and get it to market. Both Abelow and Kozinets teach developing products that meet the customer's needs, therefore there is motivation or suggestion to combine with a reasonable expectation of success. All the claim limitations are taught by the combination of Abelow and Kozinets.

- **[Claim 3]** the additional consumer is selected from among conceivers of similar business methods and experts in the business field to which the discussed business method relates (Abelow: col. 10, lines 40-49, Abelow teaches the authoring system and data analysis system could turn this architecture into a "point-of-use" distribution system for leading professionals to sell their know-how and services directly to users.).
- **[Claim 10]** at least one additional consumer other than the conceiver of the business method that relate to the core method, participates via the communication network in the discussion of the business method that relate to the core method (Kozinets: para 16, Kozinets teaches online, loyal consumers evaluate quality together and negotiate standards.).
- **[Claim 11]** the additional consumer who participates in the discussion of the business method that relate to the core method, is selected from among the conceiver of the core method, conceivers of the similar business methods,

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and experts in the business field to which the discussed business method relates (Abelow: col. 10, lines 40-49, Abelow teaches the authoring system and data analysis system could turn this architecture into a "point-of-use" distribution system for leading professionals to sell their know-how and services directly to users.).

11. **Claims 5-9, 12-17 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Abelow (U.S. Patent 5,999,908) in view of Kozinets (Kozinets, How Online Communities are Growing in Power, Financial Times, London (UK), 9 November 1998, p.6 [PROQUEST]) and further in view of Harshaw (U.S. Patent 5,542,871). As to claim 5, Abelow and Kozinets disclose a method and system for implementing a business method conceived by a consumer by participations of consumers but fails to teach the conceiver of the core method becomes at least one of a stockholder and a business partner of the company. Harshaw teaches the pool manager undertakes efforts to identify and market the new product to potential licensees. The rights granted by the license are given to a manufacturer in exchange for royalties on sales of the new product during the term of the patent (col. 2, lines 18-37). The Examiner interprets the parties are business partners. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the royalty payments of Harshaw with the teachings of Abelow and Kozinets since Abelow teaches users may buy this know-how by purchase order, credit card, etc. (col. 10, lines 3-14). Efficiently getting new products to market helps companies improve financial return while decreasing the cost of product development. Abelow teach a customer-based product design module that permits vendors to discover and respond instantly to market shifts and

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opportunities. By making two-way learning and information delivery part of the product and service environment, vendors or third parties can become faster, more efficient and accurate in designing, delivering and supporting what customers want to buy (Abstract). Harshaw teaches a method for developing new product for introduction into the marketplace, which increases the expectation of financial return and decreases the cost of product development (col. 1, lines 27-38). Reducing the time it takes to develop the product and get it to market saves time and money, therefore in more efficient and less costly. Both Abelow and Harshaw teach developing new products, therefore there is motivation or suggestion to combine with a reasonable expectation of success. All the claim limitations are taught by the combination of Abelow and Harshaw.

- **[Claim 6]** a predetermined proportion of profit obtained by executing the core method is shared with the conceiver of the core method (Harshaw: col. 3, lines 62-67, Harshaw teaches a first portion of royalties (e.g. 50%) is distributed to the registrant of the selected idea.).
- **[Claim 7]** a predetermined proportion of profit obtained by executing the core method is shared with the additional consumer who has participated in the discussion (Harshaw: col. 3, lines 62-67, Harshaw teaches a second portion of the royalties that is smaller than the first portion (e.g. 25%) is distributed equally amongst the remaining registrants within the pool.).
- **[Claim 8]** publicly opening via a communication network information containing the core method, the conceiver of the core method, how the core method was executed, and profit obtained by executing the core method (Harshaw: col. 2, lines 56-67 and col. 3, lines 29-35 and 62-67, Harshaw teaches individuals or small business registrants having a new product idea may register the idea with the appropriate pool. New product ideas are preferably submitted electronically using a computer data processing system accessible through a wide area computer network. Each registration includes at least a written description of the idea, concept, or partially developed product. Once an idea has been selected for further development, all registrants are notified of the selection. A first portion of royalties (e.g. 50%) is distributed to the registrant of the selected idea, a second portion of the royalties that is smaller than the first portion (e.g. 25%) is distributed equally

amongst the remaining registrants within the pool. The Examiner interprets the process to be a public process where information is communicated.).

- **[Claim 9]** discussing via the communication network at least one of the gathered business methods that relate to the core method, between a conceiver of the business method that relate to the core method and the company, in order to implement the business method as an executable method that increases the added value of the core method (Harshaw: col. 3, lines 52-56, Harshaw teaches that once a satisfactory degree of proprietary protection is obtained, the selected idea is licensed to a manufacturer. The manufacturer will be granted the right to make, use, sell, and distribute the selected new product in a specified geographic territory.);
- **[Claim 12]** selecting one of the business method(s) implemented as an executable method which increases the added value of the core method by discussing via the communication network as an improved method to be executed (Harshaw: col. 3, lines 29-35, Harshaw teaches that once an idea has been selected for further development, all registrants are notified of the selection.);
- opening to the public via the communication network the improved method together with an announcement of gathering proposed business methods conceived by consumers that increase the added value of the improved method (Harshaw: col. 2, lines 56-67, Harshaw teaches individuals or small business registrants having a new product idea may register the idea with the appropriate pool. New product ideas are preferably submitted electronically using a computer data processing system accessible through a wide area computer network. Each registration includes at least a written description of the idea, concept, or partially developed product.);
- gathering business methods conceived by consumers via a communication network that relates to the improved method (Harshaw: col. 2, lines 56-67, Harshaw teaches individuals or small business registrants having a new product idea may register the idea with the appropriate pool. New product ideas are preferably submitted electronically using a computer data processing system accessible through a wide area computer network. Each registration includes at least a written description of the idea, concept, or partially developed product. The Examiner interpret the process is not limited to only new ideas, therefore ideas to improve a known process or product is applicable.); and
- discussing via the communication network at least one of the gathered business methods that relates to the improved method, between a conceiver of a business method that relates to the improved method and the company,

in order to implement the business method as an executable method which increases the added value of the improved method (Harshaw: col. 3, lines 52-56, Harshaw teaches that once a satisfactory degree of proprietary protection is obtained, the selected idea is licensed to a manufacturer. The manufacturer will be granted the right to make, use, sell, and distribute the selected new product in a specified geographic territory.).

- **[Claim 13]** at least one additional consumer other than the conceiver of the business method that relate to the improved method, participates via the communication network in the discussion of the business method that relate to the improved method (Kozinets: para 16, Kozinets teaches online, loyal consumers evaluate quality together and negotiate standards.).
- **[Claim 14]** the conceiver of the improved method becomes at least one of a stockholder and a business partner of the company (Harshaw: col. 2, lines 18-37, Harshaw teaches the pool manager undertakes efforts to identify and market the new product to potential licensees. The rights granted by the license are given to a manufacturer in exchange for royalties on sales of the new product during the term of the patent. The Examiner interprets the parties are business partners.).
- **[Claim 15]** a predetermined proportion of profit obtained by executing the improved method is shared with the conceiver of the improved method (Harshaw: col. 3, lines 62-67, Harshaw teaches a first portion of royalties (e.g. 50%) is distributed to the registrant of the selected idea.).
- **[Claim 16]** opening to the public via the communication network information containing the improved method, the conceiver of the improved method, how the improved method was executed, and profit obtained by executing the improved method (Harshaw: col. 2, lines 56-67 and col. 3, lines 29-35 and 62-67, Harshaw teaches individuals or small business registrants having a new product idea may register the idea with the appropriate pool. New product ideas are preferably submitted electronically using a computer data processing system accessible through a wide area computer network. Each registration includes at least a written description of the idea, concept, or partially developed product. Once an idea has been selected for further development, all registrants are notified of the selection. A first portion of royalties (e.g. 50%) is distributed to the registrant of the selected idea, a second portion of the royalties that is smaller than the first portion (e.g. 25%) is distributed equally amongst the remaining registrants within the pool. The Examiner interprets the process to be a public process where information is communicated.).

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- **[Claim 17]** the communication network is Internet (Abelow: col. 9, lines 47-49, Abelow teaches that with a mainframe computer, minicomputer, Local Area Network (LAN) or another computer system at the vendor, the Defined Customer Desires (DCD) may be made available on-line. Harshaw: col. 2, lines 56-67, Harshaw teaches new product ideas are preferably submitted electronically using a computer data processing system accessible through a wide area computer network. The Examiner interprets on-line and wide area network as the Internet.).

Claims 20 substantially recite the same limitations as that of claims 12 with the distinction of the recited method being a system. Hence the same rejection for claims 12 as applied above applies to claims 20.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Blasko et al. (U.S. Patent 6,466,928) disclose a method and apparatus for idea development and evaluation.
- Asplen, Jr. (U.S. Patent 6,044,354) discloses a computer-based product planning system with idea development.
- Frost (U.S. Patent 5,041,972) discloses a method of measuring and evaluating consumer responses for the development of consumer products.
- Ivanov (U.S. Patent 5,706,452) discloses a method and apparatus for structuring and managing the participatory evaluation of documents by a plurality of reviewers.

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michael C. Heck whose telephone number is (571) 272-6730. The Examiner can normally be reached Monday thru Friday between the hours of 8:30am - 4:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (571) 273-6729.

Any response to this action should be mailed to:

**Director of the United States Patent and Trademark Office
P.O. Box 1450
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Or faxed to:

(703) 872-9306

[Official communications; including After Final communications labeled "**Box AF**"]

(571) 273-6730

[Informal/Draft communication, labeled "**PROPOSED**" or "**DRAFT**"]

mch
mch

15 June 2005


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